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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/329,354	06/10/99	GARG	S SP035-C5

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EXAMINER

DONAGHUE, L

ART UNIT

PAPER NUMBER

2783

DATE MAILED: 03/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

09/329,354

Office Action Summary

Application No.

09/329,354

Applicant(s)

09/329,354

Examiner

Donaghue

Group Art Unit

2783

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948 ✓
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

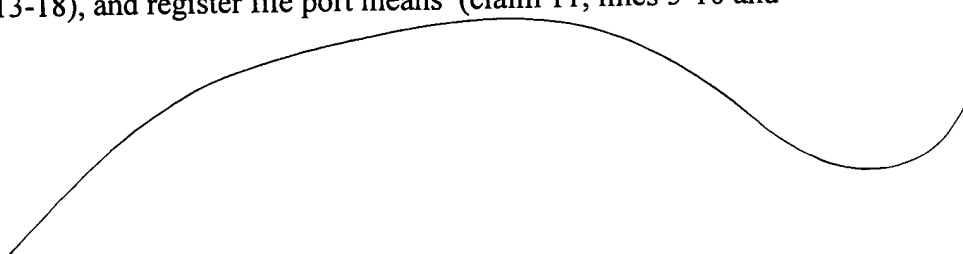
Office Action Summary

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1. Claim 1 is presented for examination.
2. Claims 2-11 have been canceled at the request of applicant.
3. Claim 1 of this application conflict with claim 1 of Application No. 09/329,352. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
4. Claim 1 is rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,497,499 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the specification are identical and the claims both the application and patent are open end. As an example Garg et al. (5,497,499) claim 12 corresponds, as follows:

Garg et al. (5,497,499) claimed a dependency checking means (clm 11, lines 11-12), a tag assignment means (clm 11, lines 13-18), and register file port means (claim 11, lines 5-10 and 19-20).



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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claim 1 is rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,737,624 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the specification are identical and the claims both the application and patent are open end. As an example Garg et al. (5,737,624) claim 12 corresponds, as follows:

Garg et al. (5,737,624) claimed dependency checking means (clm 1, lines 9-16), a tag assignment means (clm 1, lines 9-16), and register file port means (claims 3-6).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

6. Both references 5,737,634 and 5,497,499 were cited by applicant on paper no. 2.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claim 1 is rejected under 35 U.S.C. § 102(e) as being clearly anticipated by

Nguyen et al. (5,448,705).

See fig. 4-6 and 10-12.

9. Nguyen et al. was cited by applicant on paper no. 2.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Lightner et al. ("The

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data dependence checking means (page 14, section 2.1, paragraph 2); tag assignment means (page 15, section 2.2; page 14, section 2.1, col. 2); and a register file having storage locations for storing executed results (page 14, section 2.1, paragraph 4) and temporary storage locations for storing according to said tags (fig. 1; page 14, section 2.1, paragraphs 2-4).

The Lightner et al. reference was cited by applicant on paper no. 2.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to L. Donaghue whose telephone number is (703) 305-9675.

The examiner can normally be reached on M-F from 8:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An , can be reached on (703) 305-9678. The fax phone number is (703) 306-5404 .

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



LARRY D. DONAGHUE
PRIMARY EXAMINER